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REMARKS

Claims 1-57 are currently pending in the subject application and are presently under consideration. Amendments to the claims are shown at pages 3-13 of this Reply. Claims 21, 37, 45, 48, 49, 50, and 54 have been amended herein to further emphasize novel aspects of the subject invention. Claims 1-13, 15-20, 22-36, 38-44, 46-47, and 51-53 are amended herein to correct minor informalities. Additionally, the specification has been amended to correct minor informalities as indicated at page 2. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

**I. Rejection of Claims 48-54 Under 35 U.S.C. §101**

Claims 48-54 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. It is respectfully submitted that this rejection is improper for at least the following reasons. The subject claims produce a useful, concrete, and tangible result.

Because the claimed process applies the Boolean principle [abstract idea] *to produce a useful, concrete, tangible result* ... on its face the claimed process comfortably falls within the scope of §101. *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358. (Fed.Cir. 1999) (Emphasis added); *See State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed.Cir.1998). The inquiry into patentability requires an examination of the contested claims to see if the claimed subject matter, as a whole, is a disembodied mathematical concept representing nothing more than a "law of nature" or an "abstract idea," or if the mathematical concept has been *reduced to some practical application rendering it "useful."* *AT&T* at 1357 citing *In re Alappat*, 33 F.3d 1526, 31 1544, 31 U.S.P.Q.2D (BNA) 1545, 1557 (Fed. Cir. 1994) (Emphasis added) (holding that more than an abstract idea was claimed because the claimed invention as a whole was directed toward forming a specific machine that produced the useful, concrete, and tangible result of a smooth waveform display).

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Independent claims 48, 49, 50, and 54 have been amended herein to further emphasize that the subject claimed invention produces a useful, concrete, and tangible result. For example, amended independent claim 48 (and similarly amended independent claims 49 and 50) recites receiving information from a consumable(s) monitor associated with a welder *via* a network regarding consumable usage; and invoicing a customer for the consumable based at least in part upon the information received regarding the consumable usage. Thus, independent claim 48 (and similarly independent claims 49 and 50) produces the useful, concrete and tangible result of generating an invoice based upon consumable usage information that is received *via* a network from a consumable(s) monitor that is related to a welder.

Moreover, the Office Action dated December 27, 2004 contends that “[t]he invention as recited in the claims is merely an abstract idea that is not within the technological arts.” (Office Action, pg. 2). However, independent claim 48 (and similarly independent claims 49 and 50) has been amended herein to recite receiving information *from a consumable(s) monitor associated with a welder via a network* regarding consumable usage. Therefore, it is believed that the claims as amended are limited to the technological arts.

Additionally, independent claim 54 has been amended herein to recite a system for communicating a signal between a welder and a remote system, comprising: a welder having a consumable(s) monitor and communicating information regarding consumable(s) usage *via* a signal; and, a remote system that facilitates managing welding consumable(s) for the welder based at least in part upon information received from the consumable(s) monitor *via* the signal. The signal is employed in connection with the system such that is it provided by the welder to the remote system to communicate information related to consumable(s) usage. Thus, the signal utilized in conjunction with such a system has been reduced to a practical application rendering it useful.

In view of the above, it is readily apparent that the claimed invention reduces to a practical application that produces a useful, concrete, tangible result and is limited to practical applications in the technical arts; therefore, pursuant to *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358 (Fed.Cir. 1999), the subject claims are

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directed to statutory subject matter pursuant to 35 U.S.C. §101. Accordingly, this rejection should be withdrawn.

## II. Rejection of Claims 1-57 Under 35 U.S.C. §103(a)

Claims 1-57 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sekizawa (U.S. 2003/0212929) in view of Official Notice. Withdrawal of this rejection is respectfully requested for at least the following reasons. Sekizawa does not teach or suggest all of the limitations set forth in the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, *the prior art reference (or references when combined) must teach or suggest all the claim limitations.* See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. See *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

Applicants' claimed invention relates to a system and method for managing welding consumables. In particular, independent claim 1 (and similarly independent claims 21, 37, 38, 43, 45, 48, 49, 50, and 54) recites *a welder having a consumable(s) monitor*; and, a remote system that interfaces to the *welder via* a network... Sekizawa fails to teach or suggest such claimed aspects of the subject invention.

More particularly, Sekizawa relates to monitoring information related to network printers. (See abstract). For example, Sekizawa discloses receiving status information related to an operation state of each network printer, an amount of toner remaining for each printer, an amount of ink remaining for each printer, and a remaining life for a photosensitive drum associated with each printer. Thus, Sekizawa is directed towards

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monitoring properties associated with *printers*. Sekizawa fails to teach or suggest employing a *welder*. Furthermore, Sekizawa is silent in regards to utilizing a *welder with a consumable(s) monitor*. Moreover, Sekizawa does not provide a teaching or suggestion for utilizing a *remote system that interfaces to a welder via a network*. Additionally, the Office Action acknowledges that "Sekizawa does not expressly disclose a system for managing welding consumables." (See Office Action dated December 27, 2004, pg. 4). Accordingly, Sekizawa fails to teach or suggest such claimed aspects.

The Examiner, however, takes Official Notice that "data identifying a type of equipment being monitored is not functionally related to the substrate of the system." (See Office Action dated December 27, 2004, pg. 4). It is additionally contended that "it would have been obvious to a person of ordinary skill in the art at the time the invention was made to monitor any type of equipment because such equipment type does not functionally relate to the substrate of the system and merely monitoring equipment of different types would have been obvious." (See Office Action dated December 27, 2004, pg. 5). Applicants' representative respectfully disagrees. In particular, the subject claims relate to monitoring welders, which are commonly utilized in industrial environments, *via* a computer network. Thus, the subject invention evaluates a device that is typically not in communication with computers. In contrast, Sekizawa is associated with monitoring a device (*e.g.*, printer) that is typically employed with computers. Accordingly, applicants' representative respectfully traverses the aforementioned Official Notice and it is believed that this rejection should be withdrawn.

Moreover, Sekizawa is not analogous to the subject claimed invention. Sekizawa is neither in the field of endeavor nor reasonably pertinent to the particular problem with which the invention was concerned.

The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned." *In re Oetiker*, 977

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F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)  
(See MPEP §2141.01(a)).

Sekizawa relates to evaluating the status of printers within a network environment. Sekizawa, however, is not related to an industrial environment in which welders are employed. On the contrary, the subject invention, can mitigate problems typically encountered in manufacturing operations related to inventory management, profitability, and production control. (See pg. 2, ll. 3-25). Accordingly, Sekizawa is not analogous to the subject invention.

In view of at least the foregoing, it is readily apparent that Sekizawa in view of Official Notice does not teach or suggest the subject invention as recited in independent claims 1, 21, 37, 38, 43, 45, 48, 49, 50, and 54 (and claims 2-20, 22-36, 39-42, 44, 46-47, 51-53, and 55-57 which directly or indirectly depend there from). Accordingly, this rejection should be withdrawn.

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CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [LINCP105US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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